



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : John C. Smith et al.
Serial No. : 09/761,580
Filed : January 18, 2001
Title : METHODS

Art Unit : 1634
Examiner : Juliet C. Einsmann

COPY OF PAPERS
ORIGINALLY FILED

Commissioner for Patents
Washington, D.C. 20231

RECEIVED

JUL 22 2002

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed April 9, 2002, and further to the action mailed February 13, 2002, and the response thereto filed March 13, 2002, applicants elect the single polymorphism at position 1255 of SEQ ID NO:1. However, this election is made with traverse.

First, applicants point out that all of the polymorphisms specified in the elected claims (claims 1-2) relate to a single gene and its encoded protein, PDH E2. Since a single search will reveal the art relevant to all of these polymorphisms, there is certainly no burden on the examiner to search all four.

Second, the polymorphism at nucleotide position 1255 of SEQ ID NO:1 corresponds to the polymorphism at amino acid residue 349 of SEQ ID NO:2; i.e. anyone with a polymorphism at residue 349 will also have a polymorphism at nucleotide position 1255. Thus a search that encompasses one will be adequate to cover the other. The same is true of nucleotide position 857 of SEQ ID NO: 1 and amino acid residue 216 of SEQ ID NO: 2. Again, there is no burden on the Examiner to search the polymorphism at both the nucleic acid and the amino acid levels. It would seem odd to separate them.

Finally, applicants point out that claims 1 and 2 cover determining the sequence at one or more of the four positions. If the restriction requirement is allowed to stand, it will limit applicants to claiming a method of determining the sequence at only one of the four positions.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

Signature

Typed or Printed Name of Person Signing Certificate

Applicant : John C. Smith et al
Serial No. : 09/761,580
Filed : January 18, 2001
Page : 2

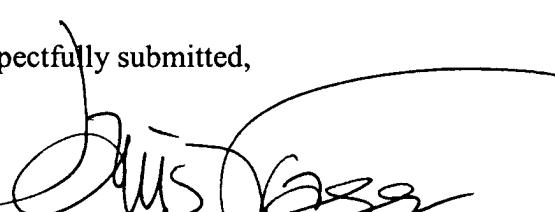
Attorney's Docket No. 06275-286001 / AFG/Z70640-1
US

The restriction requirement ignores those embodiments of the claims in which the sequence at two, three or all four positions is determined. It essentially prohibits applicants from ever presenting such claims, in this application or any divisional.

Applicants strongly protest and request withdrawal of the restriction requirement at least insofar as it requires election of a single polymorphism.

Enclosed is an Associate Power of Attorney granting Power of Attorney to the undersigned and requesting that future communications be directed to the undersigned. Also enclosed is a Petition for Extension of Time for two months and a check for \$400. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,


Janis K. Fraser, Ph.D., J.D.
Reg. No. 34,819

Date: July 9, 2002
Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906